UTILITY PATENT ATTORNEY DOCKET NO. CIL1736

REMARKS

The Claimed Invention

The claimed invention is directed to a figure eight shaped exercise device and method of using the device while suspending a user's arm while walking or jogging.

The Pending Claims

Prior to entry of the above amendments, Claims1-20 are pending. Claims 1-19 are directed to a figure eight shaped exercise device for use in suspending a user's arm while walking or jogging. Claim 20 is directed to a method of using the device.

The Office Action

Claims 1, 2 and 3 stand rejected under 35 U.S.C. 102(b) as being anticipated by Hebert.

Claims 4-8, 10 and 15-19 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Hebert.

Claims 1 and 20 stand rejected under 35 U.S.C. 102(b) as being anticipated by Kuhl.

Claims 11-14 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Kuhl.

Claim 9 stands rejected under 35 U.S.C. 103(a) as being unpatentable over Darkwah in view of Quinones.

RESPONSE TO SPECIFIC OBJECTIONS AND REJECTIONS

The Examiner's specific objections and rejections are reiterated below as small indented bold print, followed by Applicants' response in normal print.

REJECTION UNDER 35 U.S.C. §102(b)

2. Claims 1, 2 and 3 are rejected under 35 U.S.C. 102(b) as being anticipated by Hebert.

Hebert discloses a device comprising; first and second hoop members pads attached/handles attached to each hoop. The handles/pads being freely fitted and thereby rotatable on said hoop members.

The Applicant has subsequently canceled claims 1, 2 and 3 without prejudice. Therefore, the basis for rejection has been removed. Accordingly, this rejection should be withdrawn.

FIRST REJECTION UNDER 35 U.S.C. §103(a)

4. Claims 4-8, 10 and 15-19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hebert.

The examiner notes that it is well known in the art of manufacturing handles and pad member to manufacturing handles and pad member to manufacture both from a variety of materials such as metal wood leather and plastics. The considers these selection of materials as obvious unless the applicant can convincingly prove the criticality of using any of these specific materials within the claimed device.

The Applicant has subsequently canceled claims 4-8, 10 and 15-19 without prejudice. Therefore, the basis for rejection has been removed. Accordingly, this rejection should be withdrawn.

SECOND REJECTION UNDER 35 U.S.C. §103(a)

5. Claims 1 and 20 are rejected under 35 U.S.C. 102(b) as being anticipated by Kuhl.

Kuhi teaches providing a device which is formed in a fig. 8 (see abstract) having a plurality of handles/pads (12) and using the device as claimed in claim 20, as broadly as claimed 20 is claimed.

The Applicant respectfully traverses this rejection in part because the Examiner has failed to carry the burden of presenting a prima facie case of novelty

Regarding claim1:

The Applicant has subsequently canceled claims 1 without prejudice. Therefore, the basis for rejection has been removed. Accordingly, this rejection should be withdrawn.

Regarding claim 20:

It is well settled that in order to anticipate a reference must teach each and every claimed element of the invention. The Applicant respectfully points out that the Examiner has failed to carry the burden of presenting a *prima facie* case of novelty because the Examiner has not even addressed as single step in method claim 20. That is, the Applicant respectfully traverses this rejection of method Claim 20 because the Examiner has improperly based this rejection upon the forbidden *per se* arbitrary declarations because the Examiner has failed to support this rejection with even a scintilla of evidence. That is the Examiner has evoked an empty decree that Claim 20 is somehow anticipated by the Kuhl reference without providing support for his conclusions.

In particular, it appears that this rejection simply ignored all of the requisite steps of required in Claim 20, i.e. the steps of "adjusting, gripping, inserting, jogging, obtaining, running, slipping, suspending, and walking." This type of cursory evaluation of the Applicants patent application coupled with an unsupported anticipation rejection decree leaves the Applicant with the conclusion that the Examiner has erred by basing this rejection on a forbidden *per se* declaration.[1]

Accordingly, this rejection of method Claim 20 is based on the forbidden type of *per se*

[1] See for example In re Pleuddemann, 910 F.2d 823, 15 USPQ 2d 1738 (Fed. Cir. 1990).

rules which ignores the statutory requirements of assessing patentability, and therefore this rejection is improperly based.

As a consequence, for all of the reasons stated above, the Applicant respectfully submits that this rejection of method Claim 20 under 35 U.S.C. §102(b) should be withdrawn. Accordingly, the Applicant respectfully asserts that Claim 20 is now in condition for allowance.

THIRD REJECTION UNDER 35 U.S.C. §103(a)

> **6. Claims 11-14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kuhl.**
>
> **The examiner notes that it is known to manufacture jogging exercise equipment wherein it is florescent and reflective. Note jogging shoes which include reflective material and are often manufactured in florescent colors.**
>
> **In regard to claim 11 the examiner note that stretchable fabric would be an obvious and common substitute for elastic cords, so long as it is elongated and stretchable.**

The Applicant has subsequently canceled claims 11-14 without prejudice. Therefore, the basis for rejection has been removed. Accordingly, this rejection should be withdrawn.

FOURTH REJECTION UNDER 35 U.S.C. §103(a)

> **7. Claim 9 is rejected under 35 U.S.C. 103(a) as being unpatentable over Darkwah in view of Quinones.**
>
> **The examiners notes that it would have been obvious to make the handle means of Darkwah weighted of at least one pound in view of the weighted handles of the jogging device of Quinones.**

The Applicant has subsequently canceled claim 9 without prejudice. Therefore, the basis for rejection has been removed. Accordingly, this rejection should be withdrawn.

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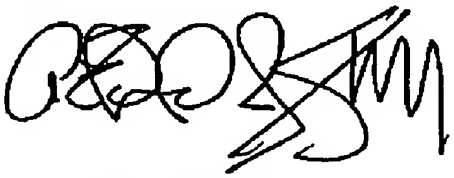
CONCLUSION

In view of the above amendment and remarks, it is submitted that this application is now ready for allowance. Accordingly, reconsideration and reexamination are respectfully requested in view of the above amendments and remarks. Early notice to that effect is solicited. If in the opinion of the Examiner, a telephone conference would expedite the prosecution of the subject application, the Examiner is invited to call the undersigned attorney at (512) 306-0321 .

Respectfully submitted,



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Date: October 17, 2005

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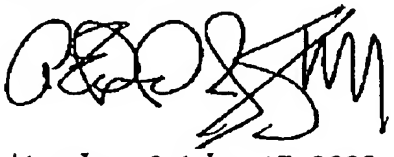

Monday, October 17, 2005

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